

REMARKS

In view of the following remarks, reconsideration of the rejections set forth in the Office Action of April 8, 2009 is respectfully requested.

In the outstanding Office Action, the Examiner rejected all of pending claims 13 and 18-26 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner noted that the claims as amended in the response filed February 24, 2009 require that the plasma spraying is performed in a manner such that the "average area *covered by* each molten particle of the metal thermal spraying material when the molten particles have stuck to the surface of the metal body is 10000 μm^2 to 100000 μm^2 to thereby form the spray coating" (emphasis added). However, the Examiner has asserted that there is no support in the original disclosure for this subject matter. Specifically, the Examiner noted that the original claims simply recited an "average area" which allowed for multiple interpretations of this phrase, and the Applicants' attempt to clarify the phrase was allegedly not supported by the original disclosure.

On pages 4 and 5 of the Office Action, the Examiner acknowledged the Applicants' arguments as to why the phrase "covered by" now recited in independent claim 13 was supported by the original disclosure. However, the Examiner asserted that arguments provided simply by the Applicants' representative (i.e., attorney argument) cannot take the place of evidence in the record. Therefore, because the Applicants did not provide any evidence in support of the explanation (or amendment language) submitted with the amendment of February 24, 2009, the Examiner asserted that the amendments constitute new matter lacking support in the original disclosure.

As discussed with the Examiner during a telephone interview conducted June 23, 2009, one of ordinary skill in the art would readily understand from the original disclosure that the language of currently-pending claim 13 is supported by the original disclosure. As initially proposed on page 5 of the Office Action, the Examiner suggested providing evidence, such as a declaration, to support this position. In particular, the Examiner confirmed during the telephone interview that the outstanding rejections would be reconsidered if a proper declaration executed by one of ordinary skill in the art was submitted in response to the Office Action.

In view of the above, the Applicants have submitted herewith a Declaration executed by one of ordinary skill in the art. In particular, the Declarant has extensive experience in the field of thermal spraying, has authored or co-authored numerous publications relating to this technology, and is therefore well qualified to provide an opinion on the issue of what would be understood by one of ordinary skill in the art of thermal spraying. Furthermore, the Declarant has set forth numerous facts on which the conclusion was reached, including sections of the original disclosure and the Declarant's knowledge of the art, which supports the Declarant's ultimate conclusion. Specifically, the conclusion in the Declaration is that one of ordinary skill in the art would clearly understand that the phrase "average area" appearing in the original disclosure means "average area *covered by* each molten particle," as asserted by the Applicants in the previous response.

In view of the evidence submitted in the form of the Declaration discussed above, as well as the discussion with the Examiner during the telephone interview of the June 23, 2009, and the Applicants' previous arguments in the response filed February 24, 2009, it is clear that one of ordinary skill in the art would readily understand that all the subject matter recited in presently-pending independent claim 13 is fully supported by the original disclosure. Consequently, the Examiner is respectfully requested to withdraw the rejections under 35 U.S.C. §112, first paragraph.

At the bottom of page 5 of the Office Action, the Examiner acknowledged that the previous prior art rejections were overcome with the Amendment submitted February 24, 2009. Moreover, during the telephone interview, the Examiner confirmed that there are no other outstanding issues or rejections other than the written description rejections noted above. Consequently, in view of the submission of the Declaration and the above remarks, it is submitted that this application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicants' undersigned representative at the telephone number provided below.

Respectfully submitted,

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